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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,135	12/17/2001	Andreas Langsdorf	P/633-12	4726
2352	7590	11/01/2004	EXAMINER	
OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			LOPEZ, CARLOS N	
			ART UNIT	PAPER NUMBER
			1731	

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/023,135	LANGSDORF ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Carlos Lopez	1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 01 October 2004.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 4 and 5 is/are allowed.
- 6) Claim(s) 1-3 and 6-16 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/1/04 has been entered.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, and 6-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Di Candia (US 3,908,735). Di Candia discloses a membrane body made of porous material 103 having channels 104 for the introduction of compressed gas to flow through the porous material. The intended use limitation, "to levitate the glass gobs above the gas outlet surface of the membrane body", is deemed to be a functional limitation capable of being performed by Di Candia. It is reasoned that if the porous membrane body as disclosed by Di Candia can be used to move molten steel as noted in col. 3, lines 13ff, it would be obvious to one of ordinary skill in the art at the time the

invention was made, that Di Candia's device is capable of levitating small glass gobs as claimed.

It is also noted that gas passing through the channel formed in the porous membrane 103 allows gas to escape through the porous membrane and out through the outlet surface of the porous material 103.

Furthermore is also noted that the fact that the claimed invention is for the use of levitating glass gobs in comparison to Di Candies' device, intended for the flow of steel, said intended use does not overcome the Di Candia reference because it does not further structurally distinguished it over Di Candia. It is also noted that the newly intended use limitation being addressed above is not to be considered as carrying patentable weight. Said discussion is only being made to further note on the record that the structural features of Di Candia's device is capable for other uses such as that claimed by applicant.

As for claims 3 and 12, channels 104 pass through the porous membrane body 103 and opens to the outlet surface of the porous material 103 and to the surface opposite the outlet surface as best shown in figure 3.

As for claims 2 and 11, as shown in figure 4, the channels 104 are at an acute angle to the outlet surface.

As for claims 6 and 13, the distance between the channel 104 and the outlet surface, which is deemed as the surface which the compressed air exits as best shown in figure 4, is less than half the thickness of the membrane body 103.

As for claims 7 and 14, the channels pass from one surface of the porous membrane to another as shown in figure 4.

As for claims 8 and 15, the outlet channels are positioned at a position across the membrane body to provide compressed gas to the outlet surface.

As for claims 9 and 16, the outlet surface is a horizontal upper surface.

As for claim 10, Di Candia's porous membrane is deemed as an arrangement being operable to introduce glass gobs.

#### ***Response to Arguments***

Applicant's arguments filed 10/1/04 have been fully considered but they are not persuasive. Applicant argues that Di Candia is non-analogous art since it is drawn to casting steel, a method, and not the production of glass gobs. However, since applicant's invention is drawn to a device, a porous membrane, and not to a production of glass gob said argument is unpersuasive.

Applicant also argues that there exist no motivation to modify Di Candia in the manner suggested by the office action because the Examiner has not provided a rationale why a person of ordinary skill in the art would be motivated to employ the Di Candia device, related to casting, to levitate glass gobs. The claimed invention is drawn to a device per se having a porous membrane with channels therein. Hence there is no need to show motivation to employ Di Candia's device to levitate glass but merely show the claimed structural limitations read on Di Candia's device and is capable of levitating glass. See MPEP 2114 reciting the following:

"While features of an apparatus may be recited either structurally or functionally, claims<

directed to >an< apparatus must be distinguished from the prior art in terms of structure rather than function. >In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971);< In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original)."

In the instant case applicant's arguments regarding its intended use do not distinguish the claimed invention in terms of structure.

In regards to the argument that Examiner must provide a motivation to modify the reference, it is noted that there is no modification being made to the Di Candia reference.

Applicant argues that Di Candia discloses outlet ports for receiving molten steel, not gas channels for receiving compressed gas. It appears applicant regards outlet ports 2 as the claimed gas channels, when in fact glass channels 104 are deemed as the claimed channels.

Applicant also argues that Di Candia does not disclose every feature of the claimed invention. Applicant argues that Di Candi does not relate to the formation of glass gobs but rather a totally unrelated field of casting steel. The alleged limitation argued by applicant as "formation of glass gobs" has been previously been deemed as being intended use limitation that does not structurally define the claimed device from

that of Di Candia. Applicant only emphasizes the intended use of the claimed invention as arguments for distinction when in fact structural distinction from the Di Candia reference is required. AS previously noted, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Reference A has been cited to show the state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is 571.272.1193. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571.272.1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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